

R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

The rejection of claims 1-8 and 10-20 under 35 U.S.C. §102(e) as being anticipated by Silverman, et al. (U.S. Patent No. 6,370,603, hereinafter Silverman) is respectfully traversed and should be withdrawn.

Silverman is directed to configurable universal serial bus (USB) controller implemented on a single integrated circuit (IC) chip with media access control (MAC).¹

In contrast to Silverman, the presently claimed invention (claim 1) provides a serial interface engine (SIE) configured to (i) automatically generate a response to a request when the request is a first type of request that the serial interface engine is configured to recognize and (ii) pass (a) the request from the interface circuit to an external circuit and (b) the response to the request from the external circuit to the interface circuit when the request is a second type of request that the serial interface engine is not configured to recognize. Claims 12 and 13 include similar limitations.

The Federal Circuit has stated that "[a]nticipation requires the presence in a single prior art reference disclosure of

¹See Title of Silverman.

each and every element of the claimed invention, **arranged as in the claim.**"² The Federal circuit has added that the anticipation determination is viewed from one of ordinary skill in the art: "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention."³ As explained herein below, because Silverman does not disclose or suggest each and every element of the presently claimed invention, arranged as in the present claims, Silverman does not anticipate the presently claimed invention.

Specifically, a Declaration of Andrew Warren under 37 C.F.R. §1.132 is submitted herewith (attached as Exhibit A) providing evidence of how Silverman would be viewed by a person of ordinary skill in the field of the invention. In particular, the portions of Silverman cited in the Office Action would not be understood by a person of ordinary skill in the field of the invention as disclosing or suggesting an SIE configured to automatically generate a response to a request when the request is a first type of request that the serial interface engine is configured to recognize, as presently claimed (see paragraph numbers 7, 10 and 11 in the Declaration of Andrew Warren under 37 C.F.R. §1.132, attached as Exhibit A). Therefore, the Office Action does not meet the Office's burden of factually establishing

²*Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added).

³*Scripps Clinic & Research Found. V. Genentech Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991).

a *prima facie* case of anticipation. As such, the presently claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

Furthermore, contrary to the position taken on pages 2-3 of the Office Action, Silverman is silent regarding the SIE 206 automatically generating a response to a request, as presently claimed (see paragraph 12 in the Declaration of Andrew Warren under 37 C.F.R. §1.132, attached as Exhibit A). Since Silverman is silent regarding the SIE 206 automatically generating a response to a request, it follows that Silverman does not disclose or suggest a serial interface engine (SIE) configured to (i) **automatically generate a response to a request when the request is a first type of request that the serial interface engine is configured to recognize** and (ii) pass (a) the request from the interface circuit to an external circuit and (b) the response to the request from the external circuit to the interface circuit when the request is a second type of request that the serial interface engine is not configured to recognize, as presently claimed. Therefore, the Office Action does not meet the Office's burden of factually establishing a *prima facie* case of anticipation. As such, the presently claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

Furthermore, a person skilled in the field of the invention would recognize the serial interface engine of Silverman as being a conventional USB SIE that acts as a conduit passing USB

requests and data from a host to an outside intelligence and responses from intelligence to the host (see paragraph 13 of the Declaration of Andrew Warren under 37 C.F.R. §1.132). FIGS. 1 and 2 in the specification clearly distinguish the presently claimed invention from a conventional SIE. Furthermore, the Office Action fails to specifically point to the language in Silverman which supports the conclusion that the SIE 206 of Silverman is configured to generate automatically responses to a request when the request is of the first type of request, as presently claimed (see paragraphs 14 and 15 of the Declaration of Andrew Warren under 37 C.F.R. §1.132). Therefore, the Office Action does not meet the Office's burden of factually establishing a *prima facie* case of anticipation. As such, the presently claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

With respect to claim 7, assuming, *arguendo*, "the USB device of Silverman must strictly adhere to USB protocol set forth in the standard USB Specification [and] therefore a descriptor table must be used in Silverman" (as suggested in lines 14-16 on page 3 of the Office Action and for which Applicant's representative does not necessarily agree), the Office Action fails to make specific findings, present objective evidence or provide a convincing line of reasoning that the SIE of Silverman is responsible for supporting the USB protocol. Furthermore, the Office Action fails to allege, let alone show that the Serial Interface Engine of Silverman comprises a memory configured to

store information comprising a descriptor table, as recited in claim 7. Therefore, the Office Action fails to meet the Office's burden to factually establish a *prima facie* case of anticipation. As such, claim 7 is fully patentable over the cited reference and the rejection should be withdrawn.

With regard to the rejections of claims 6, 10 and 13-20, it is unclear which logic circuit of Silverman the Office Action is referring to in the rejections. As such, the rejections do not appear to meet the Office's burden to clearly and distinctly state the basis of a rejection (see 37 C.F.R. §1.104). Applicant's representative respectfully requests that the Examiner clearly explain the basis for the rejections or withdraw the rejections.

Furthermore, the Office Action appears to be taking the position that it is inherent that the serial interface engine of Silverman contain a descriptor table. However, the Office Action fails to present any evidence or convincing line of reasoning that one of ordinary skill in the art would view the serial interface engine of Silverman as necessarily containing a memory configured to store a descriptor table as presently claimed.

Furthermore, the statements in the Office Action that "it is clear [that] if the request is a standard USB request the SIE must generate a response, since the standard USB request is recognized by the SIE" and "USB transactions are handled by the SIE using standard USB protocol and other non-USB transactions unrecognizable by the SIE via USB interface 204 will be handled by the PLD/PGA via the SIE and USB interface" (see page 7, lines 3-5

and lines 13-15 of the Office Action) are not supported by the cited reference (see paragraph nos. 14 and 15 in the Declaration of Andrew Warren under 37 C.F.R. §1.132). As such, the presently claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

For the above reasons, the Office Action fails to meet the Office's burden (i) to factually establish that Silverman discloses or suggests each and every element of the presently claimed invention, arranged as in the present claims and (ii) to show that there is no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. As such, the presently claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

Claims 2-11 and 14-20 depend, either directly or indirectly, from claims 1 and 13 which are believed to be allowable. As such, the presently claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claim 9 under 35 U.S.C. §103(a) as being unpatentable over Silverman is respectfully traversed and should be withdrawn.

Claim 9 depends directly from claim 1 which is believed to be allowable. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

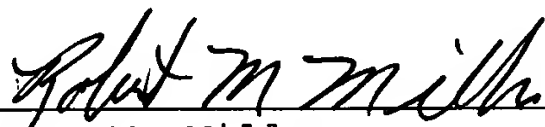
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicant's representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office Account No. 50-0541.

Respectfully submitted,

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